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Anthony Robin White

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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/939,491
Filing Date: August 24, 2001
Appellant(s): WHITE, ANTHONY ROBIN

Mark P. Bourgeois
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 21, 2006 appealing from the Office action mailed October 7, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

Plant Breeder's Right grant, 4711, was published on August 15, 1999 for the Community Plant Variety Office of the European Community with regards to the clematis cultivar 'Avalanche.'

Internet website <http://dspace.dial.pipex.com/clematis/prop.htm> for information on how to propagate clematis.

Appellant's response to the request for information under 37 CFR 1.105 regarding the sale or distribution of the plant anywhere in the world prior to the filing date and if the sale was an obscure solitary occurrence.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by European Community Plant Breeder's Rights grant no. 4711 (published August 15, 1999) in view of Appellant's admission that 'Avalanche' was sold in the United Kingdom in the fall of 1998 (page 3 of reply filed September 17, 2002). The application requires information pertaining to any prior sale. This document is open to public inspection. This is also evidenced in the UPOV-ROM GTITM Computer Database citation under the heading "DATE PUBL.GRANT/REG". Additionally, the Appellant, Breeder and Assignee are all listed on this publication. As a result, one of ordinary skill in the art would have known whom to contact to purchase the plant.

The grant was published on August 15, 1999, more than one year prior to filing of the instant application. The grant is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See MPEP § 2128. The Community Plant Variety Office publishes applications for variety protection. Once the Breeder's Grant is made, the variety and description are entered in the Plant Variety Protection Register. The register, grant and published applications are accessible to the public. This information was available on-line as well as in CD-Rom format as of the date listed that the grant/filing was published which in this case was August 15, 1999 and is more than one year prior to filing of the patent application in the United States. Additionally, copies of the grant are obtainable through the

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Community Plant Variety Office for the European Union. Thus, information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) (“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the references are enabling. Public availability of the plant, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the claimed plant. Appellant has admitted that the claimed plant was for sale more than one year prior to application for U.S. patent and thus was in the public domain. *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states “When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar” (1041) and “the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available” (1043). Appellant’s admission that ‘Avalanche’ was sold in the United Kingdom in the fall of 1998 does not appear to be an obscure or isolated occurrence. Selling to a wholesaler is not obscure or isolated because the purpose of the wholesaler was to increase plants for further commercial production. There is nothing that indicates that the plant would not have been offered to other interested parties. The end result was the plant was in the public domain as soon as it was offered to the wholesaler. Absent

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evidence of the relationship between the wholesaler and the licensed propagator, it is assumed this constituted the first offering to the “public.” It is immaterial whether the public was the wholesaler, retailer, or other parties. The Internet website

<http://dspace.dial.pipex.com/clematis/prop.htm> discloses how to asexually propagate clematis.

As a result, one of ordinary skill in the art could have bought the plant and asexually propagated it, thus reproducing the invention without undue experimentation. Therefore, the claim is anticipated by the published Plant Breeder’s Right Grant.

(10) Response to Argument

Appellant argues (page 10 of brief) that if documents are not readily obtainable by the U.S. Patent Office that has access to a vast array of resources, why would they be available to an isolated plant breeder. This is not found persuasive because the Plant Breeder’s Right documents, besides being referenced on the Internet, are available to the public at the Community Plant Variety Office. Thus the “degree of availability” is analogous to the fact situation in *In re Wyer*, where patent documents were available at a foreign patent office.

Appellant argues (page 10 of brief) that the public use and availability of the subject plant variety outside of the United States is not material to a determination of “plant patentability” of a plant variety in the United States under 102(b). The rejection is based on a printed publication, not public use/on sale. The printed publication bar applies no matter where the publication was made. Public availability of the plant shows that the publication was “enabled”. Appellant’s argument is not persuasive to patentability, as there is no geographic component of enablement. For example, for a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See *Ex parte Rinehart*, 10 USPQ2d, 1719, (Bd. Pat. App. & Inter. 1989). A printed publication identifying the breeder and assignee of a particular plant in combination with the public availability of the plant places the plant in the public possession. Response in paper number 3, page 3, Appellant admits the invention was “the first sale date was in the United Kingdom in the fall of 1998.” *In re Elsner* “the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available” (1043).

Appellant argues (pages 10-11 of brief) that a non-enabling printed publication by itself nor foreign public use cannot be cited as prior art under 102(b) and *Ex parte Thomson* combined two non-prior art references. Appellant’s arguments are not persuasive, as the propriety of this type of rejection was recently affirmed by the Court of Appeals for the Federal Circuit. *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states, “However, because the public may have had access to the claimed inventions through the foreign sales of the plants, from which the claimed plants may be reproduced, it may fairly be said that the PBR applications are adequately enabled. Because the published applications, combined with the foreign sales of the plants, placed the claimed inventions in the possession of the public, we therefore hold that they are proper 102(b) anticipatory references that may bar patentability” (page 1042). As stated above, Appellant admits the sale of the claimed cultivar occurred in the United Kingdom in the fall of 1998, more than one year before the filing date of the instant application. *Elsner* also states, “Only when possession derived in this manner enables a person of skill in the art to practice asexual reproduction of the plant in a manner consistent with the statute can a non-enabling publication and foreign sales act as a 102(b) bar” (page 1041). “The foreign sale must not be an obscure,

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solitary occurrence that would go unnoticed by those skilled in the art” (page 1043). Therefore, the published PBR application and the accessibility of the foreign sale of the claimed plant, and the knowledge of reproducing a clematis as described on the Internet website

<http://dspace.dial.pipex.com/clematis/prop.htm> would elicit a rejection under 35 U.S.C. 102(b).

Appellant argues (page 11 of brief) that it is improper to rely on a combination of references to anticipate the claimed invention under 35 U.S.C. 102(b). Examiner would like to point out that the admission of Appellant that the plant was for sale more than one year prior to application for U.S. patent is not “supplementing” the primary reference, rather the sale of the plant provides proof that the primary reference was enabling. The Examiner would like to point out how the two cited cases support the rejection that was made under 102(b). As noted in *In re Samour*,

“a printed publication which discloses every material element of the claimed subject matter, would constitute a bar under 35 USC 102(b) to appellant's right to a patent if, more than one year prior to appellant's filing date, it placed [the claimed subject matter] ‘in possession of the public.’ Whether claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art.” 197 USPQ at 3-4 (citations omitted).

The court noted that a printed publication that places the invention in possession of the public would constitute a bar under 35 USC 102(b). This language is also used in *LeGrice* as is discussed in further detail below. A printed publication identifying the breeder and assignee of a particular plant in combination with the public availability of the plant places the plant in the public possession.

The court further noted that the disclosure in the primary reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, and that it is appropriate to rely on additional references solely as evidence that, more than one year prior to appellant's filing date, a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the art. 197 USPQ at 4.

Appellant argues (page 12 of brief) that for the American public to get access, use and duplicate a plant variety, propagatable plant material from the plant in question must be available in the United States. Without access to the plant material, the plant cannot be reproduced. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States. This is not found persuasive because Appellant is reminded that the rejection is over a

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publication. Additionally, the customs and quarantine importation procedures have nothing to do to enable a publication.

Appellant argues (page 12 of brief) that *In re LeGrice* case was concerned with whether or not foreign plant varieties are actually available to the American public. This is incorrect. *LeGrice* was concerned with whether printed publications must be enabled to anticipate a claimed invention. In *LeGrice* there is no requirement for access to the plant by Americans. Also, Americans could have purchased the plant and imported it (through quarantine). Biological material is considered available even if it must pass through quarantine. See MPEP 2404.01 (last paragraph). The question in *LeGrice* was whether publications must be enabling to support a rejection under 102(b). The answer was yes, the invention must be in possession of the public. Public use or sale can put the invention in the public domain. Once the claimed plant is in the public domain, printed publications are enabled because one can readily obtain the starting materials necessary to make the invention, as set forth in the *Thomson* decision.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

S.B. McCormick-Ewoldt

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